

### **REMARKS**

This is in response to the Office Action mailed on December 30, 2004, and the documents cited therewith. Claims 1, 3, 4, 5, 6, 7, 8, 9, 10, 13, and 14 are amended; claims 15 and 20 are cancelled, as a result, claims 1-14 and 16-19 are now pending in this application. The amendments are to clarify the subject matter that applicants regard as their invention. The Examiner is requested to note that the amendment of claim 1 as presented herein does not narrow the claims and accordingly does not surrender any equivalent to which the substituents may be entitled. No new subject matter is added.

#### **§1.75 Objection of the Claims**

Claim 9 was objected to under 37 CFR § 1.75 as being a substantial duplicate of claim 10. Applicants have amended claim 10 to overcome this rejection. Accordingly, it is respectfully requested that this objection be withdrawn.

Claim 13 was objected to under 37 CFR § 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicants have amended claims 1 and 13 to overcome this rejection. Accordingly, it is respectfully requested that this objection be withdrawn.

#### **§112 Rejection of the Claims**

**Claims 3 and 4 were rejected under 35 USC § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.** To the extent that this rejection may be maintained with respect to the pending claims, it is respectfully traversed.

Applicants have amended claims 3 and 4 to clarify the subject matter that applicants regard as their invention. The Examiner is requested to note that the amendment of these claims is to clarify the claims and does not limit the subject matter claimed. Accordingly, it is respectfully requested that this objection be withdrawn.

*Obviousness-Type Double Patenting Rejection*

**Claims 1-20 were rejected under the judicially created doctrine of obviousness-type double patenting as allegedly unpatentable over claims 1-5 of U.S. Patent No. 6,545,034, in view of Spiegelman et al. (USP 6,552,055).** To the extent that this rejection may be maintained with respect to the pending claims, it is respectfully traversed.

**Claims 1-20 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting rejection as allegedly unpatentable over claims 10, 14-20, 49, 50 and 52-54 of co-pending Application No. 09/634,207.** To the extent that this rejection may be maintained with respect to the pending claims, it is respectfully traversed.

To moot the above rejections, while not conceding the obviousness of any number of the pending claims over the claims of the '034 patent or the claims of the '207 application taken alone or in combination with the '055 patent, Applicants enclose herewith a Terminal Disclaimer in compliance with 37 C.F.R. 1.321(b)(iv), to overcome this rejection. The Examiner is requested to note that Applicants are disclaiming the terminal part of the statutory term of any patent granted on the above-identified patent application (Serial No. 10/753,665), which would extend beyond the expiration date of the full statutory term, as presently shortened by any terminal disclaimers, of U.S. Patent No. 6,545,034 or the patent to issue from Application Serial No. 09/634,207. Withdrawal of this rejection is therefore appropriate and is respectfully requested.

**Claims 1-20 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting as allegedly unpatentable over claims 1-8, 10 and 12-23 of co-pending Application No. 10/682,790 in view of Spiegelman et al. (USP 6,552,055).** To the extent that this rejection may be maintained with respect to the pending claims, it is respectfully traversed.

It is noted that this is a provisional double patenting rejection because the claims of the '055 patent have not been allowed. However, Applicants submit that the instant claims are not obvious in view of the claims of the '790 application taken alone or in combination with the '055 patent. The claims of the '790 application are directed to compounds having a formula that may be similar to the compounds of the instant claims. However, applicants note that the claims of

the '790 application require an alkylating agent. It is respectfully submitted that it would not be obvious to remove the alkylating agent required in the claims of the '790 application to obtain the instant claims. The '055 patent fails to disclose or suggest that the compounds of the instant claims will function as claimed, without an alkylating agent. In addition, there is no motivation to lead a person skilled in the art to modify the method of the '790 application to obtain the claimed method, based on the disclosures of the '055 patent.

Accordingly it is respectfully requested that the objections for obviousness-type double patenting be withdrawn.

Conclusion

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at (612) 373-6968 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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Date

June 15, 2005

By

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Reg. No. 33,995

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: MS Amendment, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 15<sup>th</sup> day of June, 2005.

Name

Dawn M. Poole

Signature

Dawn M. Poole